Office Supreme Court, U. S.
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CLERK.

166-432

# SUPREME COURT OF THE UNITED STATES.

## OCTOBER TERM, 1896.

## No. 16, ORIGINAL.

THE UNITED STATES, EX REL. PHILLIP HIEN,

vs.

THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

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*Answer of the respondents.*

For answer to the rule served upon them to show cause why a mandamus should not be issued as prayed in the petition of the relator in the above-entitled cause, these respondents say:

They have no knowledge or information, further than as they are informed by the petition aforesaid and by the record which has been furnished to them of certain proceedings in the Patent Office, that the petitioner claims to have been the first and original inventor of a certain invention described in his petition, and therefore they can neither admit nor deny the allegations of the petition in that regard. In the said proceedings the Commissioner of Patents decided that one William A. Pungs, and not the petitioner, was the first and original inventor of the said invention. Nor have they any knowledge or information further than as they are in the same manner advised of the transactions and proceedings in the Patent Office set forth by the petitioner.

But it is true that an appeal from the decision of the Commissioner of Patents in an interference proceeding, wherein said petitioner and said William A. Pungs were parties, was filed in this court; and upon a motion for the appellee, Pungs, to dismiss the same, such appeal was dismissed on the ground that it had not been taken within the time limited therefor by the rules of this court made in pursuance of law and under the authority of the statute creating this court.

On June 5, 1893, this court promulgated general rules of practice for the conduct of the business therein, among which were the following:

"Rule IX. No order, judgment, or decree of the supreme court of the District of Columbia, or of any justice thereof, shall be reviewed by the court of appeals, unless the appeal shall be taken within twenty days, Sundays excluded, after the order, judgment, or decree complained of shall have been made or pronounced."

"Rule XIX. The appeals from the Commissioner of Patents shall be subject to all the rules of this court provided for other cases therein, except where such rules, from the nature of the case or by reason of special provisions inconsistent therewith, are not applicable."

These rules were in force on the 9th day of June, 1894, when the decision aforesaid of the Commissioner of Patents was rendered; and various appeals from the decisions of the Commissioner of Patents were taken and prosecuted under them.

Subsequently, on representation that the period of twenty days so allowed for appeals from the decisions of the Commissioner was too short for persons living at a distance from the city of Washington, this court, on September 29, 1894, promulgated a new rule in the premises, which is as follows:

"Rule XX, part 2. The appellant, upon complying with the preceding section of this rule, shall file in the case a petition, addressed to the court, in which he shall briefly set forth and show that he has complied with the requirements of sections 4912 and 4913 of the Revised Statutes of the United States to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the Commissioner; and said appeal shall be taken within forty days from the date of the ruling or order appealed from and not afterwards."

In disregard of this rule and of the preceding rule upon this subject, the petitioner waited for nearly two years before taking his appeal from the decision of the Commissioner in the interference proceeding aforesaid, and only filed his appeal in this court on June 2, 1896.

Thereupon, upon motion made to that effect, said appeal was dismissed for failure to take and prosecute the same in due time. Subsequently on motion by the petitioner to reinstate the cause on the ground that this court had no authority to make the rule or rules in question, this court reaffirmed its action and refused to reinstate the cause. Such ground for reinstatement was for the first time set forth in said motion last mentioned and was not brought forward on the motion to dismiss the appeal or in opposition thereto.

Wherefore these respondents, having fully answered, pray to be hence dismissed.

Further answering the said rule, these respondents pray leave to refer to their opinions rendered upon said motions as filed by the petitioner with his petition.

R. H. ALVEY,
*Chief Justice Court of Appeals.*
M. F. MORRIS,
*Associate Justice Court of Appeals.*
SETH SHEPARD,
*Associate Justice Court of Appeals, D. C.*

(Indorsed:) Supreme Court U. S. October term, 1896. Term No. 16. Orig'l. Ex parte. In the matter of Phillip Hien vs. Petitioner. Return to rule. Filed Feb. 27, 1897.

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## SUPPLEMENTAL BRIEF FOR PETITIONER.

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W. H. SINGLETON,
F. W. RITTER, JR.,
*Of Counsel.*

BYRON S. ADAMS, PR.

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## BRIEF FOR PETITIONER.

(SUPPLEMENTAL.)

W. H. SINGLETON,
F. W. RITTER, JR.,
*Of Counsel.*

While no points of law are specifically enumerated in the Brief Against Petition, yet those which appear to be urged may thus be summed up:

**First.**

The Commissioner of Patents has made an order to withhold from issue for a certain time the application of the successful party in an interference so as to give the losing party an opportunity to appeal to the court.

The answer to this is, that no order of the Commissioner of Patents can aid in settling the question whether the appellate court may fix a limit of appeal from him to such court. Moreover, it is open to very serious question whether the Commissioner of Patents has any authority to make an order relative to appeals from him, as they are outside of his office.

**Second.**

That Hien had ample notice of the rules of the court and the order of the Commissioner, and yet he failed to comply with the rules and contends he has two years under the statute.

This is simply a *petitio principii*, as it is the very question brought up by the petition for the writ of mandamus.

**Third.**

Limit of appeal is an element of taking an appeal.

It is thought that petitioner's brief (Additional) fully answers this point.

And even the citations made in Brief Against Petition do not sustain the above point.

Page 237 of Encyclopedia of Pleading and practice simply states that an appeal is taken when such essentials of an appeal appear before the limit expires as stops the running of the limit. That is, the "*taking*" must occur within the limit, but the citation does not say that the limit is a part of the taking.

And in Lowell *v.* Lowell, 55 Cal., 316, the Court holds that the "undertaking" must be filed within the time limited by the code. Nothing is said about any limit being a part of the taking. As has been shown by the citations in Petitioner's Brief, Additional (page 11), this Court has held that the undertaking may be made after the limit has expired, provided the appeal was taken before the expiry of such limit.

In Hull *v.* Westcott, 17 Fla., 280, it was held that the appeal must be dismissed because not taken in time. Of course! Petitioner does not contend but that failure to appeal in time is ground for dismissal. His contention is that his appeal was in time. Time is of the essence of petitioner's contention. So that Hull *v.* Westcott does not apply.

## Fourth.

"Furthermore, Section 6 of the Act of July 30, 1894, is an amendment to Section 6 of the organic act which provided for the time and method of the entry of appeals, and it simply puts the original section in more concise and terse language, without repealing what was in said section. To hold otherwise would seem to be a strained and unreasonable construction."

Brief Against Petition, page 8.

If it be admitted that amendatory Section 6 is no different from the original Section 6, then most assuredly petitioner's contention must stand.

As has been clearly set out in petitioner's original brief (*ex-parte* record, pages 50–51) original Section 6 gave authority for limiting only appeals from the Supreme Court of the District of Columbia. This lower *Court* is specifically named, and of course, therefore, appeals from the Commissioner of Patents are not included.

## Fifth.

The Court has inherent right to make rules.

However, unfortunately for the application of this point to the present contention, the citations expressly state that the rules of court must not be "contradictory to the laws of the land," and that a court may frame rules "when no mode of appeal is provided by the legislature" (Brief Against Petition, page 9).

Now petitioner's contention is that the rule complained of is "contradictory to the laws of the land," and the legislature has provided so much of the mode of appeal as relates to the limit. Because an appeal is such a prosecution of an application as is contemplated by R. S., Sec. 4894.

**Sixth.**

R. S., Sec. 4894, does not apply.

"First, because it simply regulates proceedings in and within the Patent Office, and second, because it relates to a wholly different matter—abondonment of an application—and not the taking of an appeal." (Brief Against Petition, page 11.)

As to the first part of this point this Court in Gandy *v.* Marble has said that this section of the law does apply to appeals from the Patent Office. That settles this branch of this point. It should also settle the second branch of the point.

But as to the socond part it may be said that unless an appeal be taken there is an abandonment of the rejected matter. A rejection subject to appeal certainly is an action upon an application. And just as certainly the appeal from this rejection is the only logical prosecution of the application which the action of rejection calls for. Therefore, when an application is rejected, subject to appeal, unless the applicant prosecutes his application by appealing, the charge of abandonment, contained in Section 4894, may be made against him. A rejection by the Commissioner of Patents in person, subject to an appeal to the Court of Appeals of the District of Columbia, is as much an action on an application as a rejection by any of the lower tribunals of the Office subject to an appeal to a higher tribunal. And an appeal in either case is a prosecution of the application, and the statute allows two years for such prosecution.

At the bottom of page 11, Brief Against Petition, an attempt is made to show the distinction set out in this point. It is contended that if Hien's claims 1 and 2 were decided in favor of Pungs, "there could be no such thing as abandonment of these two claims by Hien under this section of

the statute, as the claims had been awarded to another against him, whether he took an appeal or not." However, it is admitted that the Commissioner decided these two claims adversely to Hien, and that he should have appealed from such decision. Here the contention is that as the Commissioner had decided Hien's claims 1 and 2 in favor of Pungs therefore there could be no abandonment of them by Hien. Now, the very abandonment contemplated by R. S., Sec. 4894, is where an applicant has an adverse action and makes no prosecution of his case for two years. When in an interference there is a decision in favor of one party, there is a rejection of the other. When one party is adjudged entitled to a patent because no bar exists, the other is *ipso facto* rejected, because a bar exists against his claim, to wit, that his invention was "known or used by others before his invention or discovery thereof," to wit, by the opposing party. The losing party in an interference thus having the disputed claim rejected has a remedy by appeal. If he fail to prosecute his case within two years after rejection abandoment is presumed against him.

In the present case Hien's application was rejected on June 9, 1894, when the Commissioner of Patents gave the award in favor of Pungs, and on June 13, 1894, there was a formal rejection of claims 1 and 2 (*prima facie* record, page 19). Under R. S., Sec. 4894, unless Hien prosecuted his application it would have been abandoned. And the only prosecution was an appeal which he took within the statutory limit. Most certainly, therefore, Hien's claims 1 and 2 would have been abandoned had he not appealed, as they were rejected for lack of invention, which the Commissioner had held resided in Pungs.

**Seventh.**

That Hien had not two years limit in which to appeal as to claims 1 and 2, rejected by the Commissioner, but had two years in which to pay the final fee and obtain the other claims (Brief Against Petition, page 12).

If Hien had two years in which to prosecute his case after any action on any part of it, he had the same time to take action on the whole of the case, as R. S., Sec. 4894, makes no discrimination.

**Eighth.**

That Gandy *v.* Marble does not apply to this present contention, as this is not a case of abandonment, but of appeal.

This has been answered already. But further, while it may not be a question of the abandonment of the entire application, it most certainly is a question of the abandonment of claims 1 and 2.

**Ninth.**

That as the Commissioner of Patents under R. S., Sec. 4904, may fix a limit in interferences within the Patent Office, the Court may outside.

In the first place, the Commissioner of Patents has no authority to fix a limit of appeal within the Patent Office; R. S., Sec. 4904, simply gives the Commissioner of Patents authority to withhold for a certain length of time the grant of a patent to the successful party in an interference to see if the unsuccessful party appeals within the limit. But this is in the nature of a supersedeas against the successful party. *It is not a limit of appeal against the unsuccessful party.* Here lies the error. R. S., 4904, does not give the Commissioner of Patents authority to fix a limit of appeal, but a limit for withholding the issue of a patent. If the losing party fail to appeal within the limit, and thus stop the issue of a patent to the winning party, the latter gets his

patent. But the unsuccessful party still has the two years within which to take his appeal, as R. S., Sec. 4894, says, to prosecute his application within two years after any action thereon. For this section makes no distinction between what are styled *ex-parte* and contested cases, but applies to all patent cases.

But even if the Commissioner of Patents has authority to fix a limit within the Patent Office this is no argument that the appellate court has any such authority, whatever might be thought as to its advisability. Petitioner stands on the law. And no analogy can upset positive law. If Congress has seen fit to give the Commissioner of Patents authority to fix a limit within the Patent Office in interference cases which do not apply to other cases, no such authority has been given to the appellate court. And no argument on the grant of authority to the Commissioner can aid the contention that such authority has been given to the appellate court.

Moreover, the Commissioner of Patents has made rules applying to each class of cases separately, while the Court of Appeals applies one rule to all cases and the rule of Court cannot be held sound as to one class of cases, and unsound as to the other. It must stand and fall as to both.

In fact, the grave error into which has fallen counsel for respondents, is in trying to make a distinction between what is termed, for convenience, *ex-parte* and contested cases in the Patent Office. The law makes no distinction. Nor in fact is there any. The Patent Office is a bureau of one of the executive departments, and not in any sense a court. There are no contested cases in the Patent Office in the sense that there is a suit in the court.

An inventor files an application for a patent. If there be no other applicant or a patentee claiming the same invention, the application is regarded as *ex-parte*, because there

is but one party laying claim to the invention. But if in the opinion of the Commissioner of Patents there are two parties claiming the same thing, whether applicants or an applicant and a patentee, he has the authority, under R. S., Sec. 4904, to institute what is styled an interference. But this is not a contested case; it is simply a part of the machinery of the Patent Office to determine which of several applicants is the prior inventor. It is true that the Patent Office has adopted some of the machinery of an equity court; allows each party to examine and cross-examine witnesses, and follows the rules of evidence, etc.

But there is no issue affirmed by one party and denied by the other. There is no single issue which is the essential of a suit in court. In fact very often in interference cases in the Patent Office there are more than two applications involved. There are in reality as many issues as there are applicants. Because the real question involved in an interference is, at what date each party invented the invention in controversy. Each party adduces evidence to show when he invented it, and also, if feasible, to show that the other party did not invent it at the time alleged by him. Here are several distinct issues, and not one issue, as in a suit.

Moreover, instead of following the analogy of an equity suit, and allowing each party to present his own case, the Commissioner of Patents might have adopted another plan, as he has done in public use cases, and have some representative of the Patent Office conduct the entire examination, examining the witnesses on behalf of both parties.

As a matter of fact the parties in an interference proceeding are witnesses on behalf of the Commissioner so that he may be advised as to which of the parties is the prior inventor.

Because an application is put into what is technically

styled an interference the applicant does not thereby lose his rights under the statute, nor at all change his status before the Patent Office.

A decision in an interference is just as much an action on the part of the Patent Office as a decision in what is styled an *ex-parte* case. And therefore all actions in the Patent Office fall under R. S., Sec. 4894.

And there are no exceptions to the ruling of this Court laid down in Gandy *v.* Marble.

Respondent's brief concludes with an appeal as to the equity of the rule in question. If a rule be without statutory authority, it cannot stand, however equitable it may be.

A court cannot legislate. Whatever may be the opinion of the personnel of a court they must construe the law, and as they find the law so decide.

It is no argument in favor of the rule to say that if the two-year limit be held good the unsuccessful party could delay for that time and hold the successful party back that length of time. But if the rule is to be held valid simply because it might work a hardship for the successful party in an interference by holding him back two years, then it most assuredly does not apply in the present case, because the successful party is the patentee. And the very fact that such a contention as the above can have no force when the successful party is a patentee removes its pertinency to the matter in hand.

But it is not true that a two-year limit to the unsuccessful party would hold the successful party for two years. While there is a provision for a supersedeas in an interference case within the Patent Office, there is none for a supersedeas after an interference has been decided by the Commissioner in person. This may be a defect. But it is a fact. If a defect, then what is needed is more legislation. And the court cannot help out defective legislation. Although the

unsuccessful party has two years in which to appeal, the Commissioner of Patents has no authority to hold the successful party a single day. There is no provision of law by which the Commissioner of Patents may hold up the application of the successful party so as to see whether the other will appeal to the court.

Whatever may be, or may be thought to be, the equity of the matter, there is no law for a supersedeas on the successful party, nor a less limit than two years upon the unsuccessful party.

All of which is respectfully submitted.

W. H. SINGLETON,
F. W. RITTER, JR.,
*Of Counsel.*

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## BRIEF FOR PETITIONER.

(ADDITIONAL.)

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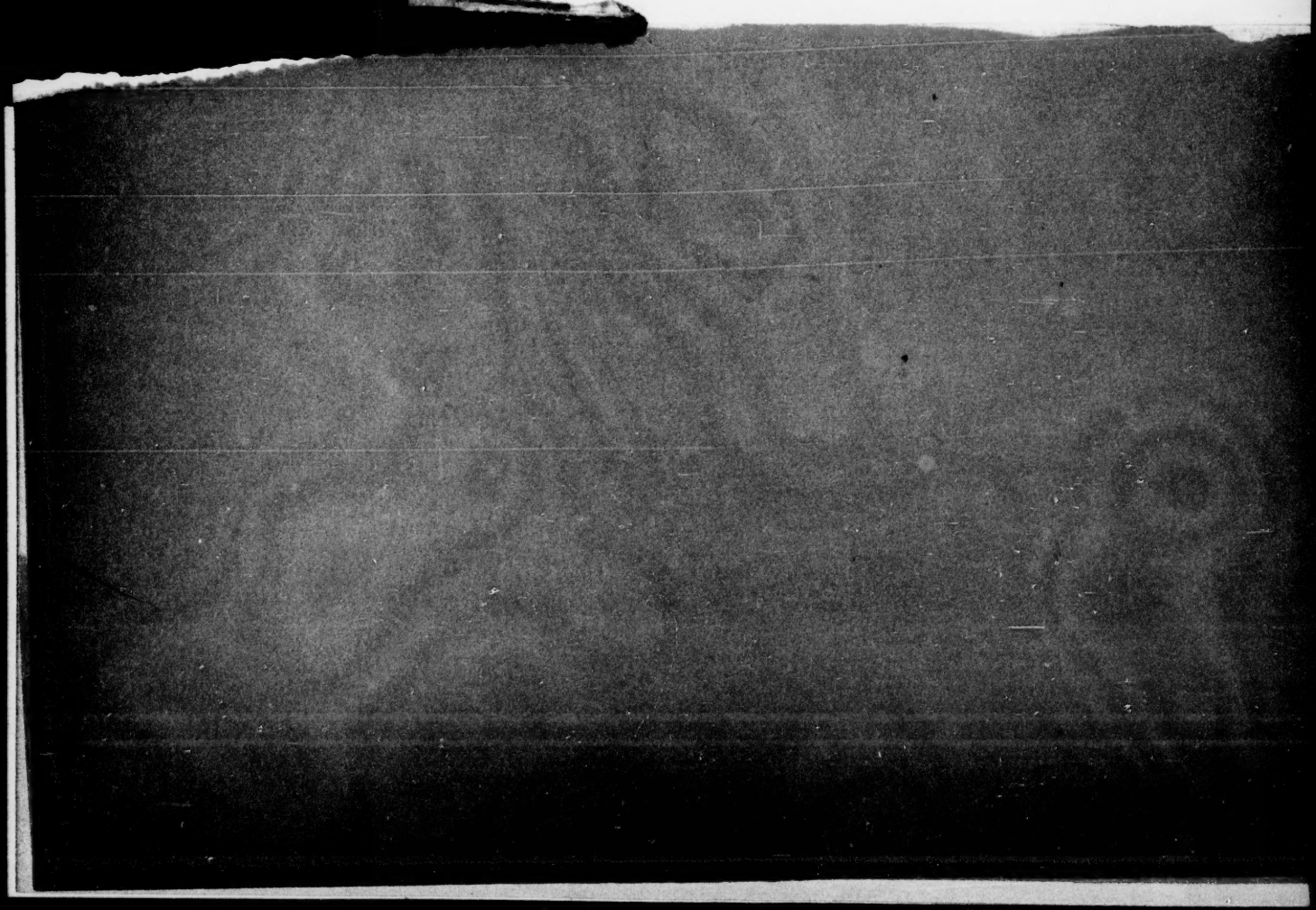

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## BRIEF FOR PETITIONER.

(ADDITIONAL.)

### STATEMENT OF THE CASE.

An application for United States patent was filed by petitioner in the United States Patent Office April 2, 1892, Serial No. 427,485; on September 30, 1892, it was put in interference with the patent to W. A. Pungs, January 12, 1892, No. 466,834, brake-beams, and the interference was decided by the Commissioner of Patents adversely to petitioner June 9, 1894.

Upon June 2, 1896, petitioner filed an appeal from the said decision of the Commissioner of Patents to the Court of Appeals of the District of Columbia; upon November 7, 1896, the Commissioner of Patents made a motion to dismiss such appeal; upon December 1, 1896, the Court of Appeals of the District of Columbia dismissed the petition

as appealed upon the sole ground that the appeal had not been filed within the limit of time set by the rules of the Court; upon December 12, 1896, petitioner filed a petition for reinstatement of the appeal upon the ground that the Court of Appeals of the District of Columbia had no statutory authority to make a rule for the time of entry of appeals from the Commissioner of Patents of a shorter limit than that provided by the statute, to wit, two years; upon January 4, 1897, said Court of Appeals dismissed said petition for reinstatement, and held that said Court of Appeals had statutory authority for making a limit of appeal less than two years from the date of the decision of the Commissioner of Patents.

Whereupon, and upon January 18, 1897, petitioner filed in this Court his petition for a writ of mandamus commanding the Court of Appeals of the District of Columbia to hear and determine his appeal from the Commissioner of Patents. And thereupon the petition was entertained, and a rule *nisi* issued returnable March 1, 1897. Upon this date an answer was filed on behalf of respondents.

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## THE ANSWER:

### POINT 1.

**The answer is a nullity, and the court should render judgment on the petition.**

Sansom *v.* Mercer (Texas), 5 S. W., 62–66.
People *v.* Salomon, 46 Ill., 333.
People *v.* Miner, 46 Ill., 384.

The answer does not contain a single rebutting fact. All that is set out in the answer is to be found in the petitioner's exhibits and brief of petitioner. In other words, the answer

does not furnish any new matter for the consideration of the Court. All that is in it was before the Court when the rule *nisi* was issued. The answer rests the case of the lower Court entirely upon its own rules, whereas the gravamen of the petition is that the Court had no statutory authority to make such rules. Upon this point the answer is totally silent. The answer is a complete nullity.

## POINT 2.

**Intendment is made against returns which do not answer the important facts of the petition.**

The People *ex rel.* Brunster *et al. v.* Kilduff, 15 Ill., 492.
C. & A. R. R. Co. *v.* Suffern, 129 Ill., 284.
The People *ex rel. v.* Crabb, 156 Ill., 155.
Board of Trade *v.* Nelson, 62 Ill. App., 541.
Central District Tel., Co. *v.* Commonwealth *ex rel.* Friend *et al.* (Pa.), 7 A., 926.

The first ten paragraphs of the petition contain statements of facts which are simply in the nature of an inducement upon which the allegation of the eleventh section is based. As to the allegations contained in the first ten sections, the answer either admits them as true, or admits that the respondents are informed as to such facts by the Patent Office records furnished by petitioner. Therefore, all the material facts contained in the inducement of the petition are admitted by the answer. And thereon the answer stops.

The gravamen of the petition, the material allegation upon which petitioner in the case rests, is found in the eleventh paragraph, and as to the allegations of that paragraph the answer is totally silent. After having set forth in the petition all material facts as matter of inducement, petitioner alleges that, in view of such facts, he is entitled to an appeal from the Commissioner of Patents to the Court

of Appeals of the District of Columbia, and that the appeal taken by him was taken within the time provided by the Statutes of the United States. The answer in no way, shape or form traverses these allegations of petitioner. While the lower court for its answer rests its case and the grounds for its decisions entirely upon its own rules, it says nothing as to its statutory authority to make such rules. It says nothing as to petitioner's allegation that under the law he is entitled to a longer time than that allowed by the rules of the Court. As therefore, the answer fails not only to answer the allegations of the petition, but the very material allegation upon which the petitioner's case rests, the writ should be granted upon the petition, as the answer does not meet the allegations of the petition.

## POINT 3.

**The right to, and limit of, appeal is regulated by Statute of the United States, and the Court cannot by any rule or order change the same.**

In U. S. *v.* Curry, 6 How., 106–112, the Supreme Court of the United States says:

"Nor had it (the lower court) any power to prescribe the time or manner in which the record was to be transmitted and the case brought before this Court. That too is regulated by acts of Congress which the Court can neither change nor modify."

"And the validity of the appeal depends altogether upon the laws of the United States, without reference to the laws of Louisiana or orders of the district court."

The writ of mandamus is sued out by petitioner upon the strength of section 4894, R. S., as interpreted by this Court in Gandy *v.* Marble, 122 U. S., 432.

R. S. Sec. 4894: "All applications for patents shall be completed and prepared for examination within two years

after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable."

In interpreting this statute in Gandy *v.* Marble this Court says:

"The decision of the Court on a bill in equity becomes equal with the judgment of the Supreme Court of the District of Columbia on a direct appeal under Section 4911, a decision of the Patent Office, and it governs the action of the Commissioner. It is, therefore, clearly a branch of the application of the patent, and to be governed by the rule as to laches and delay declared by Section 4894 to be attendant upon the application."

In Durham *v.* Seymour, Commissioner of Patents, decided April 1, 1895, 71 O. G., pages 601–603, the Court of Appeals of the District of Columbia, against whom this mandamus is asked, cited Gandy *v.* Marble, and adopted the position of this Court with regard to appeals from the Commissioner of Patents.

It is to be noted that the decision in the latter case was made after the promulgation of the rule under which petitioner's appeal was dismissed. As, therefore, the act of Congress, interpreted by this Court, provides for a two-year limit of appeal from the decision of the Commissioner of Patents to the appellate court in the District of Columbia, and the only justification which the Court of Appeals of the District of Columbia gives for dismissing petitioner's appeal to them, is that petitioner did not comply with a rule of that court making a less limit than that provided by statute, it is plain that the action of the Court of Appeals of the District

of Columbia comes under the animadversion of this Court in U. S. *v.* Curry above cited, and that the acts of Congress prevail in fixing the limit of appeal, and not the rules of the Court.

The answer of the Court contains in the seventh section an allegation which is not supported by any evidence, and may be, or may not be, correct. But whether correct or not, it in nowise affects petitioner's right to writ of mandamus. The Court states, "that various appeals from the decision of the Commissioner of Patents were taken and prosecuted" under the rules of June 5, 1893, which had been construed by the Court to fix a limit of appeal at twenty days.

In the first place the fact that various appeals had been taken within the twenty-day limit, does not exclude the idea but that appeals might have been taken after that date had any one chosen to appeal.

But even if the Court means by this assertion to contend that because other aggrieved parties have complied with its rules, that therefore the rules are valid, its contention is without force. The maxim, *communis error facit jus*, is only forceful in the construction of law, and not in the making of law. Where the law is obviously one way, common opinion cannot make it another way. And, moreover, the life of the lower court itself has been so short that no general opinion as to its acts could have the force of law, whatever general opinion might have anywhere else. If petitioner be correct in his position under the law, it is not weakened at all because no other aggrieved party has ever taken his position. The fact, as shown by the adjudicated cases in the Court of Appeals of the District of Columbia, is, that in every case such as Bryant *v.* Seymour, 77 O. G., 1399, referred to by the Court in one of its decisions in this case—

see *ex parte* record, page 35, wherein the question of laches in bringing an appeal was raised—the Court either did not decide this question, or in deciding it also decided the appeal on its merits, and in every instance affirmed the Commissioner. With an adverse decision on the merits against the appellants in those cases, it would have been clearly nugatory for them to have sued out a writ of mandamus to compel the lower court to take jurisdiction, when the Court had already decided against the party on the merits.

The above brief, in so far as the answer made by the Court is concerned, would appear to be sufficient; but as the Commissioner of Patents has seen fit to intervene in this matter, and to have had a representative specially appointed by this Court to present this case, it is deemed advisable on behalf of petitioner to brief somewhat further upon some subsidiary matters, which, even if they do not appear upon the surface, are, or may be, involved in the main contention.

## POINT 4.

**Revised Statutes, section 4894, as interpreted by this Court, is a special act providing for a limit of appeal of two years from the decision of the Commissioner of Patents to the Appellate Court of the District of Columbia, and such act is not repealed or amended by the acts relating to the Court of Appeals of the District of Columbia so as to permit such Court to make a less limit than two years.**

As a corollary from the doctrine that implied repeals are not favored, it has come to be an established rule in the construction of statutes, that a subsequent act, treating a subject in general terms, and not expressly contradicting the provisions of a prior special statute, is not to be considered

as intended to affect the more particular and specific provisions of the earlier act, unless it is absolutely necessary so to construe it in order to give its words any meaning at all.

Fosdick *v.* Perrysburg, 14 Ohio Stat., 472.
Maysville Turnpike Co. *v.* Howard, 14 B. Mon., 426.
Waldo *v.* Bell, 13 La. Ann., 329.
State *v.* Bishop, 41 Mo., 16.
Brown *v.* County Commissioners, 21 Pa. St., 37.
Gregory's Case, 6 Coke, 19 B.
Bernardin *v.* Northall *et al.*, 78 O. G., 1740–42.

Where there are two acts or provisions one of which is special and particular, and certainly includes the matter in question, and the other general, which if standing alone, would include the same matter, and thus conflict with the special act or provision, the special act must be taken as intended to constitute an exception to the general act, as the legislature is not to be presumed to have intended a conflict.

Crane *v.* Reeder, 22 Mich., 322.

As the law existing at the time of the creation of the Court of Appeals of the District of Columbia, provided for a two-year limit of appeal from decisions of the Commissioner of Patents, had it been the intention of Congress in creating this Court, to give to it the authority to change the statutory provisions regarding actions of an appellant for a patent after adverse action, such authority would be unequivocally expressed. It is to be clearly borne in mind that when the Congress passed the act creating the Court, and the amendatory act relating thereto, Section 4894 and the interpretation placed upon it by this Court was in full view of the Congress, and the original act providing for the Court of Appeals of the District of Columbia was made with full knowledge of the above section and the interpretation of this Court. As, therefore, the time at the creation of the Court of Appeals of the District of Columbia, to limit all appeals to the Appellate Court of the District of Columbia from decisions of

the Commissioner of Patents was two years, and the Congress was fully aware of such law, it is confidently submitted that the Court of Appeals of the District of Columbia cannot find any statutory authority for them to change this limit, unless such authority be fully and unequivocally set out in an act of Congress.

The Court of Appeals itself utterly failed to point out the particular place in the law from which they derived their authority. In their decision dismissing petitioner's appeal to them they simply baldly and tersely state that they have such authority. In their answer they do not even do this. But the only place in the law wherein by the greatest stretch of implication such authority could be found is in section 2 of the act approved July 30, 1894, amendatory of the act of February 9, 1893. And in this act the whole stress must be laid upon the word "taking." The Congress authorizes the Court of Appeals of the District of Columbia to "make such rules and regulations as may be necessary and proper for the transaction of its business and the *taking* of appeals to said Court." Further down in the same section the Court is authorized to make certain rules with regard to the record, and "generally to regulate all matters relating to appeals whether in the court below or in said Court of Appeals."

It is manifest from the latter language quoted that the Court of Appeals of the District of Columbia may do anything of whatever nature relative to appeals from the lower Court, that is the Supreme Court of the District of Columbia. The expression, "all matters relating to appeals," is used. Hence, by implication, the language of this section may confer upon the Court of Appeals of the District of Columbia power to fix a limit of appeal from a decision of the Supreme Court of the District of Columbia. But the very fact that the concluding language of amendatory section 6

of the act of July 30, 1894, confers upon the Court of Appeals power to regulate "*all matters*" relating to appeals from the lower court, shows that the language used in the early part of the section relating to the taking of appeals to said Court, does not mean that the Court shall regulate *all matters* relating to *all* appeals to said Court. Otherwise, the section would contain superfluous matter, and one part be but a repetition of the other. The latter part relates specifically to appeals from the lower court, and as to this all matters may be regulated; the former part relates to the taking of appeals generally, and as to these, other than appeals from the Supreme Court of the District of Columbia, the Court has power to make rules and regulations for the *taking* only of appeals.

As has been said, the act of Congress, interpreted by this Court, had already fixed a limit of appeal of two years from the decision of the Commissioner of Patents to the Appellate Court of the District of Columbia. If this section 6 was intended to allow the Court to alter that limit, clearer and more exact language would have been used than is. What is the taking of an appeal? The limit within which an appeal may be taken is in no sense a part of the taking of the appeal. The limit is merely the time within which the taking is to be done. That is, it is a period of time within which the aggrieved party may begin to take his appeal. There is no taking nor anything relating to a taking until the aggrieved party begins to take his appeal. As soon as the act of taking commences, the question of limit is gone, because he has exercised his right of taking within the limit prescribed.

Taking an appeal is a matter of right. The Court cannot prevent it, nor is the right dependent upon any judicial discretion.

Taking—a word which implies action on the part of the appellant alone. So that whatever the proceeding which may be, which constitutes, appealing, or taking an appeal, it must be something which the party can do.

U. S. *v.* Adams, 6 Wall., 101–107.

An appeal taken within the limit, if prayed for within the limit, though the security was not given until after the limit expired.

The Dos Hermanos, 10 Wheaton, 306–311.

A bond is not essential to the taking of an appeal, though it may be to its prosecution. If appeal be taken within the limit the bond may be filed afterwards.

Peugh *v.* Davis, 110 U. S., 227, Waite, C. J., appeal from the Supreme Court of the District of Columbia.

An appeal cannot be said to be taken any more than a writ of error can be said to be "brought," until it is, in some way, presented to the Court which made the decree appealed from, thereby putting an end to its jurisdiction over the cause, and making it its duty to send it to the appellate court. This is done by filing the papers, namely, the petition and allowance of appeal; where there is such a petition and allowance, appeal bond and citations.

In Brandies *v.* Cochrane (105 U. S., 262), it was held that in the absence of a petition and allowance, filing of the appeal bond, duly approved by a justice of this court, was sufficient evidence of the allowance of an appeal, and was a compliance with the law requiring the appeal to be filed in the clerk's office.

Credit Co., Limited *v.* Ark. Cent. Rwy. Co., 128 U. S., 258.

No decree in any action in equity can be refused by this Court on appeal, unless the appeal is taken within two years

after the entry of such decree. (R. S., 1008.) Appeals are subject to the same rules, regulations and restrictions as are, or may be, prescribed in law in cases of writs of error. (R. S., Section 1012.) As it is the filing of the writ of error in the Court which rendered the judgment that removes the record, the writ of error is not brought in the legal meaning of the term until it is so filed. (Briggs *v.* Norris, 52 U. S., 11 How., 204.) Nor is an appeal "taken" until it is some way presented to the Court which made the decree appealed from. (Credit Co. *v.* Ark. C. R. Co., 128 U. S., 258.)

Farrar *v.* Churchhill, 135 U. S., 609.

From the above citations it is clear that the taking of an appeal denotes action. It denotes the doing of something. It is something that is to be done by the aggrieved party And the court in the Credit Co. *v.* Ark. C. R. Co., states what this doing is. Moreover, this Court had held, as shown by the above authorities, that the security and bond though an essential of a perfect appeal, is not such a part of the taking of an appeal that it must be done before the limit expires. There would, therefore, seem to be no force in any contention, in view of the authorities, that the word "taking" includes time. There would, therefore, seem to be no warant for the construction that the grant of power to the Court of Appeals of the District of Columbia to make rules and regulations for the taking of appeals, authorizes them to fix a limit of appeal, especially in the case of appeals from the Commissioner of Patents, where the limit of two years was already set by a special provision of law.

## POINT 5.

**The Supreme Court of the District of Columbia, the predecessor in appellate jurisdiction of the Court of Appeals of the District of Columbia, made no rule fixing a less limit than two years from the decision of the Commissioner of Patents.**

This contemporaneous and uniform interpretation is entitled to weight in the construction of the law in a case of doubt or to turn the scale.

Brown *v.* U. S., 113 U. S., 568.

While, of course, whatever may have been the practice in the Supreme Court of the United States is not conclusive upon this Court, still it should be very persuasive. Section 4894 has been in force since 1870, and Gandy *v.* Marble was decided in 1887. Prior to the existence of the present Court of Appeals of the District of Columbia, no question was ever raised but that the party aggrieved by the decision of the Commissioner of Patents had two years in which to take an appeal. It remained for the present Court of Appeals to make a shorter limit.

## POINT 6.

**Although the Supreme Court of the District of Columbia since 1870 had appellate jurisdiction from the decisions of the Commissioner of Patents only in what are still ex parte cases, and the act creating the Court of Appeals of the District of Columbia gave such Court appellate jurisdiction in interference cases decided in the Patent Office, still the law governing both classes of appeals was the same.**

Act of February 9, 1893, Section 9. That the transmission of appeals from the decision of the Commissioner of Patents now vested in the general term of the Supreme Court in pursuance of the provisions of Section 780 of the Revised Statutes of the United States relating to the District of Columbia shall hereafter be, and the same is hereby, vested in a Court of Appeals created by this act; and in addition any party aggrieved by a decision of the Commissioner of Patents in an interference case may appeal therefrom to the said Court of Appeals.

The appellate jurisdiction from decisions of the Commissioner of Patents vested in the Supreme Court of the District of Columbia was transferred to the newly-erected Court of Appeals of the District of Columbia. Transfer of this jurisdiction was made without any change whatever, and without granting to the new court one vestige of jurisdiction greater than that vested in the Supreme Court of the District of Columbia. So that the Court of Appeals of the District of Columbia has precisely the same jurisdiction and same authority as, and no more and less, than the Supreme Court of the District of Columbia had, in so far as relates to such appeals as could have been taken from the decision of the Commissioner of Patents to the Supreme Court of the District of Columbia.

In addition to such appellate jurisdiction the Court of Appeals of the District of Columbia is given a further jurisdiction in what are known as interference cases. But in giving the newly-erected Court this additional jurisdiction, the Congress simply gave them such jurisdiction baldly, without in any wise specifying any details or conferring upon them any further or greater powers in such class of appeals than they had in the other class of appeals which devolved upon them by law from the Supreme Court of the District of Columbia.

In *ex parte* Zellner, 9 Wall., 244–46, this Court says relative to the Court of Claims:

"The subjects of its jurisdiction could be enlarged or diminished, but this would not disturb or in any way affect the general plan or system of its organization. If new or additional subjects of jurisdiction were conferred, the effect would be, simply, to increase the labors of the Court, the cases to be heard and determined under the existing organization."

As has been seen, only additional jurisdiction was given to the Court of Appeals in patent matters over that which

was had by the Supreme Court of the District of Columbia; and no enlarged powers were given. The jurisdiction simply was enlarged. As has been seen this Court, in *ex parte* Zellner, says that under such circumstances the Court should exercise its enlarged jurisdiction under its existing organization. That is, appeals in interference cases are to be treated just exactly like all other appeals from the Commissioner of Patents; and the Court of Appeals of the District of Columbia itself would seem to have recognized this by framing a limit of appeal for all classes of cases, interferences being included therein. And the Court by its own decision has adjudged these rules and applied them to both classes of cases. For they have applied that rule in petitioner's case which is in interference, and also applied it in Bryant *v.* Commissioner of Patents, which is what is called an *ex parte* case. So that the Court itself recognizes petitioner's position that there is simply an enlargement of jurisdiction, and not a difference of jurisdiction; an enlargement of its labors, but not of its powers.

W. H. SINGLETON,
F. W. RITTER, JR.,
*Of Counsel.*

# Supreme Court,

OF THE UNITED STATES.

OCTOBER TERM, 1896.

No. 16, ORIGINAL.

## THE UNITED STATES

EX REL.

## PHILIP HIEN

*v.*

THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF AGAINST PETITION.

W. A. MEGRATH,
*Counsel.*

WASHINGTON:
GOVERNMENT PRINTING OFFICE.
1897.

# In the Supreme Court

OF THE UNITED STATES.

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| THE UNITED STATES EX REL. PHILIP HIEN v. THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA. | *No. 16, Original.* |

## BRIEF AGAINST PETITION.

*May it please the Court:*

### STATEMENT OF THE CASE.

On June 9, 1894, the Commissioner of Patents in an interference proceeding in the Patent Office between Philip Hien, this petitioner, and one William A. Pungs, made a decision awarding priority of the invention in controversy to the said Pungs. On June 2, 1896, that is to say, two years less seven days from the date of the said decision, the said Hien filed a petition of appeal, in the Court of Appeals of the District of Columbia, from the adverse decision of the Commissioner of Patents.

On December 1, 1896, on motion that the appeal was not taken within the time prescribed by the rules of the Court

of Appeals of the District of Columbia, the Court dismissed the said appeal. On December 12, 1896, Hien filed a motion for reinstatement of his appeal on the ground—

(1) That the Court of Appeals of the District of Columbia had no statutory authority to make a rule for the time of taking appeals from the decision of the Commissioner of Patents.

(2) That the rules of the Court limiting appeals from the decisions of the Commissioner of Patents were not made in pursuance of statutory authority to enact such rules, and that the Court is without authority to promulgate a rule limiting such appeals to a time less than two years from the decision of the Commissioner of Patents.

On January 4, 1897, the Court of Appeals rendered a decision denying the motion for reinstatement.

Hein thereupon, on January 25, 1897, petitioned the Supreme Court of the United States for a writ of mandamus commanding said Court of Appeals to vacate and set aside its decisions of September 1, 1896, and January 4, 1897, and to entertain the appeal from the decision of the Commissioner of Patents and hear and determine the same.

## THE QUESTION.

The question raised by the petition and the one to be decided by the Court is—Has the Court of Appeals of the District of Columbia statutory authority to make a rule limiting the time of appeals to said Court from the decisions of the Commissioner of Patents?

## STATUTES RELATING TO THE COURT OF APPEALS.

The organic act creating the Court of Appeals of the District of Columbia, approved February 9, 1893, provided among other things;

"SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents, now vested in the general term of the Supreme Court of the District of Columbia, in pursuance of the provisions of section seven hundred and eighty of the Revised Statutes of the United States, relating to the District of Columbia, shall hereafter be, and the same is hereby, vested in the Court of Appeals created by this Act; and, in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

"SEC. 6. That the said Court of Appeals shall establish a term of the court during each and every month in each year excepting the months of July and August, and *it shall make such rules and regulations as may be necessary and proper for the transaction of the business to be brought before it, and for the time and method of the entry of appeals* and for giving notice of appeals thereto from the Supreme Court of the District of Columbia, and such other rules and regulations as may be necessary and proper in the premises."

On July 30, 1894, an amendatory act was passed, section 6 of which reads:

"SEC. 6. That said Court of Appeals shall establish by rule of court such terms of the court in each year as to it may seem necessary: *Provided, however,* That there shall be at least three terms in each year, *and it shall make such rules and regulations as may be necessary and proper for the transaction of its business and the taking of appeals to said court.*"

## RULES OF THE COURT.

Under the authority of sections 6 and 9 of the organic act, the Court of Appeals of the District of Columbia on June 5, 1893, promulgated a set of rules, Rule XIX of which related to and governed "Appeals from the Commissioner of Patents." Section 6 of this rule, reads:

"Rule XIX–6. The appeals from the Commissioner of Patents shall be subject to all the rules of this court provided for other cases therein, except where such rules, from the nature of the case, or by reason of special provisions inconsistent therewith, are not applicable."

One of this set of rules which provided for appeals other than those from the Commissioner of Patents, and which was applicable to appeals from the said Commissioner was Rule IX, which provided for the "Time and Manner of Allowing Appeals to this Court." Section 1 of this rule is as follows:

"Rule IX–1. No order, judgment, or decree of the Supreme Court of the District of Columbia, or of any justice thereof, shall be reviewed by the Court of Appeals unless the appeal shall be taken within twenty days, Sundays excluded, after the order, judgment, or decree complained of shall have been made or pronounced."

Notwithstanding the petitioner's contention as to these rules, it is submitted that these two sections of the rules are consistent and should be read together, and when so read they limited the time of appeal to the court from the decisions of the Commissioner of Patents to twenty days, exclusive of Sundays.

The Commissioner of Patents, in conformity with these rules, gave notice to parties in interference of such rule, by publishing in the Official Gazette of the Patent Office on June 5, 1894, the order of May 16, 1894, that—

"The examiners are hereby directed to withhold from issue the application of the prevailing party in interference cases for thirty days from the date of the final decision, in order that an appeal may be taken to the Circuit Court of Appeals for the District of Columbia, if desired."

The petitioner contends that section 6 of this statute did not give the Court authority to limit the time of appeals from the Commissioner of Patents; that the authority to make rules "for the time and method of the entry of appeals" related only to appeals from the Supreme Court of the District of Columbia, and that part of this section which authorized the Court to "make such rules and regulations as may be necessary and proper for the transaction of the business to be brought before it" related only to the conduct of appeals in patent cases after they were before

the Court, but did not regulate the time within which they were to be brought. It is submitted that such is not a fair interpretation of this section of the statute. By section 9 the Court of Appeals was vested with authority to review decisions of the Commissioner on appeal, and, being vested with such authority, it is believed that it was the intention of the law makers to give the Court authority to make rules to regulate the taking of such appeals and the prosecution of the same after they were taken. Section 6, fairly and broadly construed, as it should be, was the authority for the Court to make rules and regulations as may be necessary and proper for the transaction of the business brought before it in patent appeal cases and for the time and method of the entry of appeals in such cases. The rules of the Court above referred to were proper to govern such appeals and were such rules as were authorized under the statute.

It is to be noted that the decision of the Commissioner of Patents was rendered June 9, 1894. At this time the rules above referred to were in force, and Hien, this petitioner, had full and ample notice, by publication of the Commissioner's order of May 16, 1894, in the Official Gazette of the Patent Office, as well as from the publication of the rules themselves, that a time limit was set within which he might appeal to the Court, yet he did not appeal within the limit of time nor make any attempt to excuse his delay in not appealing. He now contends that he has under the statutes two years within which to take an appeal.

For the sake of argument let it be assumed, as the petitioner contends, that the organic act did not authorize the establishment of rules for limiting the time for taking appeals from the Commissioner of Patents, but only those taken from the Supreme Court of the District of Columbia, and that the rules promulgated by the Court as above referred to did not apply to patent appeals.

The act approved July 30, 1894, to amend certain sections of the organic act, provides by section 6 that the Court of Appeals " shall make such rules and regulations as may be

necessary and proper for the transaction of its business and the taking of appeals to said Court."

Under this authority the Court, when promulgating a new set of rules, September 29, 1894, made Rule XX, which relates to "Appeals from the Commissioner of Patents," and section 2 of which reads as follows:

"XX.—2. The appellant, upon complying with the preceding section of this rule, shall file in the case a petition, addressed to the Court, in which he shall briefly set forth and show that he has complied with the requirements of sections 4912 and 4913 of the Revised Statutes of the United States, to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the Commissioner; and *said appeal shall be taken within forty days from the date of the ruling or order appealed from, and not afterwards.*"

This expansion of time within which to take an appeal from twenty days under the prior rules to forty days, was made to enable persons living at a distance from the city of Washington to take their appeals to the Court.

The Commissioner of Patents, in view of this new rule, modified his order of May 16, 1894, and on April 27, 1896, notified the primary examiners of the Patent Office to withhold from issue for forty days the application of the successful party in an interference proceeding, in order that the defeated party may appeal to the Court of Appeals.

The last rule or order of the Commissioner is in the following language:

"The examiners are hereby directed to withhold from issue the application of the prevailing party in interference cases for forty-five days from the date of the final decision, in order that an appeal may be taken to the Circuit Court of Appeals for the District of Columbia, if so desired.

"The notice of May 16, 1894, to the examiners is modified accordingly."

The petitioner's argument is that while section 6 of the

act of July 30, 1894, authorizes the Court of Appeals of the District of Columbia to make rules and regulations necessary and proper for the transaction of its business and the *taking* of appeals to said Court, the *limit of appeal* has nothing to do with the *taking* of an appeal and is no part of the proceeding of the appeal; that a limit of appeal is a mere question of time within which a certain thing must be done.

This does not seem to be a fair construction of this statute. It is submitted to your Honors that the "taking" of appeals to the Court includes the limit of *time* of appeal as the time within which an appeal is taken is one of the requisites of an appeal.

On page 237 of the Encyclopædia of Pleading and Practice, Vol. 2, is found this section:

"Time for taking appeal.—(*a*) When an appeal is taken.—General statement of the rule.—An appeal is *taken* where a legal condition is performed which terminates the running of the statutes *limiting the time* for taking it."

Referring to the case of Lowell *v.* Lowell (55 Cal., 316, 318), this statement is found:

"An appeal is taken by filing and service of the notice, but it is effectual for no purpose until the undertaking is filed. The failure to file the undertaking within the time prescribed by the Code of Civil Procedure renders the notice nugatory, but if filed within that time the appeal is well taken."

On page 335 of the Encyclopædia of Pleading and Practice, Vol. 2, under the section "Dismissal of Appeal," it is stated:

"Dismissal of appeal.—1. Grounds of the motion.—A motion to dismiss an appeal is the proper remedy of the appellee for the appellant's failure to fully comply with all the technical requirements of practice for the *taking* and perfecting of such appeal."

The instances referred to in the foot-note under this section are where the notice of appeal is insufficient and where the notice is not *filed in time.*

Hull *v.* Westcott, 17 Fla., 280.

From these authorities it would seem that the time of appeal is one of the important steps in taking an appeal, and the petitioner's argument on this point has no weight.

As under this statute the Court of Appeals had authority to make rules for the *taking* of appeals, they had authority to make rules governing the steps in taking an appeal.

Furthermore, section 6 of the act of July 30, 1894, is an amendment to section 6 of the organic act which provided for the time and method of the entry of appeals, and it simply puts the original section in more concise and terse language, without repealing what was in said section. To hold otherwise would seem to be a strained and unreasonable construction. To construe this section as the petitioner suggests would be to say that there is no limit of appeal from the decision of the Supreme Court of the District of Columbia, as this is the only section of the statute that relates to taking appeals. Surely it was the intention of Congress to allow the Court to set some limit within which appeals may be taken from the lower Court, and if this section provides for this, it also includes appeals from the decisions of the Commissioner of Patents.

This statute should, if possible, be so construed that it shall stand with the broadest meaning that can be given to it, and it seems that there can be only one fair and reasonable construction, and that is that the Court of Appeals is given authority to establish rules and regulations as to the manner and time in which appeals may be taken to it, whether from the decisions of the Supreme Court of the District of Columbia or from those of the Commissioner of Patents.

But even if it could be said that the act creating the Court

of Appeals and the amendatory act did not give said Court authority to promulgate a rule limiting the time of appeal from the Commissioner of Patents, it is submitted that the Court possesses inherent power to make such a rule.

"All appellate tribunals possess certain inherent powers essential to their independence as courts of justice, the orderliness of the proceedings, preservation of their dignity, and efficiency of action."

Encyc. of Pleading and Practice, Vol. 2, p. 12.

"Every court of record has an inherent power to make rules for the transaction of its business, provided they are not contradictory to the laws of the land. Without this power it would be impossible for courts of justice to despatch the public business. Delays would be interminable, and delay not unfrequently is the object of one of the parties. Every court, therefore, must have stated rules to go by, and they are the properest judges of their rules of practice.

A. & E. Encyc. of Law, Vol. 4, p. 450, note 7.

"Where no mode of appeal is provided by the legislature, in such cases the appellate court may frame proper rules of procedure to bring the case before it."

Encyc. of Pleading and Practice, Vol. 2, p. 14.
Fla. *v.* Ga., 17 How., 491; N. J. *v.* N. Y., 5 Pet., 284;
Penn. *v.* Wheeling, 18 How., 460.

It seems, clear, therefore, that the court had authority to make such rules, unless said rules are inconsistent with some specific statute, and it will be shown further on that there is no conflict between said rules and the statute.

To the petitioner's argument that the last rule, Rule XX of September 29, 1894, was promulgated more than three months after the decision of the Commissioner of Patents and could not apply to his case, reference may be had to what the Court of Appeals said in dismissing the appeal:

"The right of appeal is not a vested right that may not be altered by statute, or by rule of the court, made in pursuance of statutory authority, to enact such rules. And when the rules of this court regulating the time for taking appeals was promulgated, the appellant became thereafter

bound by it, and having the full time limited by the rule, he has no just cause of complaint."

It seems clear that the Court meant by this language that if applicant was of the opinion that the old rules did not limit the time of appeal, the new rule clearly did, and applicant should have filed his appeal to the court within forty days from the promulgation of the rule. If necessary he should have made a request to the court that his appeal be heard, and have made a showing that this was the first and only clear rule that he was limited in time of appeal. He made no such request or showing and the Court, it is submitted, properly dismissed the appeal as not having been brought within the time limited for appeals by either the old rules or the new rule.

## SECTION 4894, REVISED STATUTES.

Having discussed the question as to the right of the Court to make rules limiting the time of appeals and the question as to whether said rules apply to the petitioner's case, the next question to be considered is whether said rules conflict with any section of the statute.

The attorney for the petitioner has advanced the proposition that section 4894, Revised Statutes, fixes the time within which an appeal may be taken to the Court of Appeals from the decisions of the Commissioner of Patents, and that this section of the statute allows two years within which to appeal, and that the rules of the Court are inconsistent with this section of the statute. In support of this proposition he cited the decision in the case of Gandy *v.* Marble, 122 U. S., 432.

Section 4894 of the Revised Statutes is as follows:

"SEC. 4894. All applications for patents shall be completed and prepared for examination within two years after the filing of the application, and in default thereof, or upon failure of the applicant to prosecute the same within two years after any action therein, of which notice shall have

been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner of Patents that such delay was unavoidable."

A careful reading of this section will show that there is not one word in it relating to the *limit of appeal*, but it has reference solely to the *abandonment* of an application by failure to prosecute the same after it has been completed.

This section does not apply; first, because it simply regulates proceedings in and within the Patent Office; and second, because it relates to a wholly different matter—the abandonment of an application—and not to the taking of an appeal.

The attorney for the petitioner is arguing that the abandonment of an application is the same as the abandonment of the right to take an appeal, and that both are covered by this section, 4894, Revised Statutes.

To show the difference between abandonment of an application and the failure to appeal claims within a certain time, let us take the case of this petitioner before this Court. Hien had six claims allowed him by the Patent Office; two of these, claims 1 and 2, were put in interference with Pungs, and after proper proceedings priority of invention covered thereby was awarded by the decision of the Commissioner of Patents, dated June 9, 1894, to said Pungs. There could be no such thing as abandonment of these two claims by Hein under this section of the statute, as the claims had been awarded to another against him, whether he took an appeal or not. The only thing reserved to Hien after the Commissioner had decided adversely to him on these two claims was to appeal and have the decision of the Commissioner reviewed and reversed, but the logic of the position assumed by Hein is that abandonment is alive and running against these claims, by virtue of section 4894, Revised Statutes. The statement of this proposition shows its illogicalness.

To the four remaining claims which were allowed and not in interference with Pungs, the provisions of section 4894 did attach. For although by failure to prosecute an appeal within the proper time as fixed by the Court of Appeals Hien lost his right to claims 1 and 2, yet his application was not abandoned and he still had his right to the remaining four claims, provided that at any time within two years from the decision of the Commissioner of Patents, dated June 9, 1894, as provided by this statute, he prosecuted his case by payment of the final Government fee and otherwise complied with the law.

GANDY *v.* MARBLE.

As to the case of Gandy *v.* Marble, *supra*, it is submitted that it is not in point in this case. That was a proceeding by a bill in equity under section 4915, Revised Statutes, to obtain a patent refused by the Commissioner of Patents. While a bill in equity under this section may be a branch of the application for a patent, yet unlike an appeal which is to be decided "on the evidence produced before the Commissioner," section 4914, Revised Statutes, it is an original proceeding, the time to begin which is not fixed except as to certain general exceptions. This Court was called upon to decide in that case whether there was a time within which a bill in equity under section 4915, Revised Statutes, should be filed, and they held by analogy it was limited to a period of two years, *i. e.*, within any time during the life of an application, so long as the application was not abandoned in the office.

It is to be noted that this decision was made as to a general proposition growing out of the fact that the application was still alive and unabandoned, and in the absence of any rule of the Court of the District of Columbia in which the bill was filed fixing the time within which such bills might be filed. It does not apply to this case where the abandonment of the application itself is not involved, and where the Court has by statute or its inherent powers made rules *limiting the time* of appeal.

DURHAM *v.* SEYMOUR.

The case of Durham *v.* Seymour, Commissioner of Patents, decided by the Court of Appeals of the District of Columbia, April 1, 1895, 71 O. G., 601,603, is no more pertinent to the matter under consideration than the case of Gandy *v.* Marble. The Durham case, like the latter case, was a proceeding by bill in equity under section 4915, and in referring to the case of Gandy *v.* Marble the Court of appeals used this language:

"In Gandy *v.* Marble (39 O. G., 1423; 122 U. S., 432-439), it was said that, although the proceeding is not a technical appeal from the Patent Office, 'yet the proceeding is, in fact, and necessarily, a part of the application for the patent,' and it was consequently held that a delay of more than two years in filing the appeal [bill in equity] after the last action upon the application had in the Patent Office was fatal under the provisions of section 4894."

This has nothing to do with the time within which an appeal from the Commissioner of Patents must be taken to the Court of Appeals. Such a question as to the time an *appeal* may be taken has never been passed upon by the courts.

The attorney for the petitioner has advanced the proposition that the authorities—

"Would seem to warrant as a legitimate conclusion that the Court of Appeals of the District of Columbia, in so far as appeals from the Patent Office are concerned, is *pro hac vice* a part of the Patent Office, and that the limitation of Section 4894 applies to appeals taken to this court as well as actions interior to the Patent Office proper."

Granting, for the sake of argument, that this is true, section 4904 of the Revised Statutes, reads:

SEC. 4904. Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant

and patentee, as the case may be, and shall direct the primary examiner to proceed to determine the question of priority of invention. And the Commissioner may issue a patent to the party who is adjudged the prior inventor, unless the adverse party appeals from the decision of the primary examiner, or of the board of examiners-in-chief, as the case may be, *within such time, not less than twenty days, as the Commissioner shall prescribe.*

It is seen by this section that in interference cases the Commissioner of Patents may set a limit of appeal from the decision of the primary examiner to the examiners-in-chief, or from the examiners-in-chief to himself in person, within any time not less than twenty days, clearly giving the right to limit appeals in interference cases to less than two years. The case of this petitioner is an *interference* case, and during its progress through the office was subject to this section of the statute and both the primary examiner and the examiners-in-chief in their decisions set a limit of appeal.

If the petitioner's ground is correct, that an appeal from the Patent Office to the Court of Appeals is part of the proceeding of the Patent Office by which a party may obtain a patent, it is submitted that when the jurisdiction over such appeals was transferred from the Supreme Court of the District of Columbia and vested in the Court of Appeals, and such jurisdiction was extended to include interference cases, as provided by section 9 of the organic act establishing the Court, then it logically follows that there may be a limit of appeal to such court in such a case as the one under consideration, not less than twenty days, as provided by section 4904, and following the plain intention of Congress, which was to limit the time of appeal in interference cases, the Court had authority to make a limit of appeal in such cases, even if it may be said, which I contend it can not be, for reasons stated, that section 4894 in other cases allows two years within which to appeal.

## EQUITY OF THE RULES.

The rules of the Court of Appeals in fixing a time limit

of appeal are reasonable and equitable, and were made in the interest of all parties. It is manifest that the Court in making these rules considered the rights and convenience of parties. The first set of rules provided for a twenty-day limit of appeal, but when it was shown to the Court that in patent cases it would be more convenient to extend the time to forty days, they made a special rule for patent cases, in which the time of appeal from the Commissioner was fixed at forty days.

Consider for a moment the effect of allowing parties, especially interfering parties, two years within which to take an appeal. The result would be that a party who was successful in the Patent Office might be willing and anxious to take out his patent in the interest of the public as well as of himself, but would be delayed in the office for two years for no good reason, but simply at the mercy of his opponent, who could, and probably would, take two years to decide on taking an appeal, and at the end of two years the defeated party might not take an appeal If a party desires to prosecute his case by appeal, he should be given reasonable time to prepare his case for presentation to the court and no more. This is the equitable rule.

What advantage can a defeated party in the Patent Office have in delaying his appeal to the court for two years? It is submitted that there are no advantages, except those that may arise from the delay in his opponent's obtaining a patent. Surely there are none to the successful party. There are, however, disadvantages to the successful party, as is plainly seen. These disadvantages should be guarded against by proper rules, not inconsistent with law, and this is what the Court of Appeals has done. These rules are fair and just to all parties and are made in the interest of all and for the purpose of expediting the business of the Court. Before the Court of Appeals was established there was no appeal to the Court in interference cases, and of course the question of time of appeal was not considered and there was no necessity nor in fact authority for any rule on this subject. The

defeated party in interference cases, however, had a right to prosecute his case by bill in equity under section 4915. But in a bill in equity case the patent to the successful party to the interference was not withheld from issue awaiting the determination of the equity proceeding. See Wells *v.* Boyle, C. D., 1888, 36; 43 O. G., 753.

## CONCLUSION.

It is submitted briefly and in conclusion that section 4894, R. S., has no bearing upon the question to be decided by this Court, but that the act establishing the Court of Appeals and the amendatory act referred to are to be looked to in ascertaining as to whether there can be a limit of appeal fixed in taking appeals from the decisions of the Commissioner of Patents. And that the law is plain and explicit that the Court can so regulate the taking of appeals, which includes the time of the appeal; that even if this is not so, the Court has inherent power to establish such rules; that said rules applied to the petitioner's case, and that the Court acted within said rules in dismissing the petitioner's appeal.

It is further submitted that the writ of mandamus as prayed for by the petitioner should not be issued.

W. A. MEGRATH,
*Special Counsel.*

March 18, 1897.

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CLERK.

# Supreme Court,

OF THE UNITED STATES.

OCTOBER TERM, 1896.

No. 16, ORIGINAL.

## THE UNITED STATES

EX REL.

## PHILIP HIEN

*v.*

THE CHIEF JUSTICE AND THE ASSOCIATE JUSTICES OF THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

BRIEF IN REPLY TO PETITIONER'S SUPPLEMENTAL BRIEF.

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BRIEF IN REPLY TO PETITIONER'S SUPPLEMENTAL BRIEF.

## ANSWER TO FIRST POINT.

The answer to the first point of the petitioner's supplemental brief is that no contention was made by respondent that an "order of the Commissioner of Patents can aid in settling the question whether the Appellate Court may fix a limit of appeal from him to such Court." It was simply stated in the brief against the petition as a matter of fact that the Commissioner of Patents, out of deference to the Court rules, and in order to make the practice of the Patent Office conform to said rules, had issued certain orders in regard to withholding from issue the case of the successful contestant in an interference proceeding until the limit of appeal set by the Court had expired.

## ANSWER TO SECOND POINT.

As to this, the brief against the petition simply stated as a matter of fact that the petitioner had ample notice of the

rules of the Court and the order of the Commissioner, so that the petitioner could not make the point that he was surprised that he did not have notice that he was limited to less than two years within which to appeal to the Court.

## ANSWER TO THIRD AND FOURTH POINTS.

These two points of petitioner's supplemental brief may be considered together, and to these points it is submitted that the petitioner has not shown that the *time* of taking an appeal is not a part of the *taking* and is not one of the requisites of an appeal, and therefore what is stated on pp. 7 and 8 of the brief against the petition has not been answered by the petitioner.

## ANSWER TO FIFTH POINT.

To petitioner's contention under this point, it may be stated that he seems to misapprehend what is stated on page 9 of the Brief Against the Petition. Petitioner argued before the Court, and, in his brief filed with his petition and in his additional brief stated, that the statute relating to the Court of Appeals did not give the said Court authority to limit the time of appeal to it and that the work "taking" in the statute did not include a time limit. What was stated on page 9 of the Brief Against the Petition shows, or was intended to show, that whether said statute did or did not give the Court such authority, the Court had inherent power to make a rule limiting the time within which appeals were to be brought before it, provided such rule was "not contradictory to the laws of the land." It would be absurd to say that a court may make a rule in violation of or inconsistent with a statute. What was said in the Brief Against the Petition on page 9 is clear, and it is this: "That the Court had authority to make such rules, *unless said rules are inconsistent* with some specific statute, and it will be shown further on that there is no conflict between said rules and the statute."—(Page 9.)

## ANSWER TO SIXTH POINT.

Under the first part of this point it is submitted to your Honors that the decision in the case of Gandy *v.* Marble

did not say, as petitioner seems to think, that section 4894, Revised Statutes, applies to *appeals* from the Patent Office. The question of appeal was not before the Court in that case and it did not pass upon or consider such a question. The question was as to when an unsuccessful party in the Patent Office could bring a *suit by bill in equity*, under section 4915, to obtain a patent. The Court held that such a *suit* could be brought so long as the application was alive and pending before the Patent Office—so long as it was not abandoned under section 4894 of the Revised Statutes.

As to the second part of the petitioner's sixth point of his supplemental brief, it is respectfully submitted that the argument advanced by the respondent as to the difference between abandonment of an application under section 4894, Revised Statutes, and forfeiture of the right of appeal under section 4911, Revised Statutes, (now sections 9 and 6, act establishing Court of Appeals, approved February 9, 1893, and section 6, act approved July 30, 1894,) was simply directed to prove that section 4894, Revised Statutes, has no relevancy as to the limit of time of *appeal*. As has been stated in the respondent's brief, the petitioner advanced the proposition as to the relevancy of section 4894, and respondent only referred to it in order to meet the argument on this point by petitioner. Section 4915, Revised Statutes, provides for an original proceeding in a Court of original jurisdiction—not an appellate court—which proceeding, it was held in Gandy *v.* Marble, must be begun in the Court during the life of the application; that is to say, within two years after the last action on the application by the Commissioner of Patents. This proceeding by bill in equity stands singly and alone as an extra method of reviewing the decision of the Commissioner of Patents. It may be gathered from this statement that the time limit in which actions under section 4915 may be instituted is a period of two years. If a suit shall be brought under section 4915 after the expiration of two years the suit will not be maintainable because of the abandonment of the application itself. Applying this to claims 1 and 2 of the petitioner's application for a patent, which were involved in interfer-

ence with his opponent and contestant, Pungs, it will be seen that there was retained to the petitioner after the adverse decision of the Commissioner of Patents the right to file a bill in equity, under section 4915, Revised Statutes, within a period of two years after the decision of the Commissioner, to have his claims reviewed by a court of equity having original jurisdiction in the matter. But it is to be borne in mind that this right is extraordinary and separate from the right of appeal from the adverse decision provided for under section 4911, Revised Statutes, (now act establishing Court of Appeals of the District of Columbia, approved February 9, 1893, and amendatory act approved July 30, 1894.)

The statutes relating to the Appellate Court are these:

"SEC. 4911. If such party, except a party to an interference, is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc.

"SEC. 4912. When an appeal is taken to the Supreme Court of the District of Columbia, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office within such time as the Commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

"SEC. 4913. The Court shall, before hearing such appeal, give notice to the Commissioner of the time and place of the hearing, and on receiving such notice the Commissioner shall give notice of such time and place in such manner as the Court may prescribe, to all parties who appear to be interested therein. The party appealling shall lay before the Court certified copies of all the original papers and evidence in the case, and the Commissioner shall furnish the Court with the grounds of his decision, fully set forth in writing, touching all the points involved by the reasons of appeal. And at the request of any party interested, or of the Court, the Commissioner and the examiners may be examined under oath, in explanation of the principles of the thing for which a patent is demanded.

"SEC. 4914. The Court, on petition, shall hear and determine such appeal, and revise the decision appealed from in a summary way, upon the evidence prodnced before the Commissioner, at such early and convenient time as the Court may appoint; and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case

the Court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case. But no opinion or decision of the Court in any such case shall preclude any person interested from the right to contest the validity of such patent in any Court wherein the same may be called in question."

Section 9 of the Act establishing the Court of Appeals is as follows:

"SEC. 9. That the determination of appeals from the decision of the Commissioner of Patents now vested in the general term of the Supreme Court of the District of Columbia, * * * shall hereafter be, and the same is hereby, vested in the Court of Appeals created by this act; and, in addition, any party aggrieved by a decision of the Commissioner of Patents in any interference case may appeal therefrom to said Court of Appeals."

The statute relating to the court of original jurisdiction is this:

"SEC. 4915. Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court having cognizance thereof, on notice to adverse parties and other due proceedings had, may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear. And such adjudication, if it be in favor of the right of the applicant, shall authorize the Commissioner to issue such patent on the applicant filing in the Patent Office a copy of the adjudication, and otherwise complying with the requirements of law. In all cases, where there is no opposing party, a copy of the bill shall be served on the Commissioner; and all the expenses of the proceeding shall be paid by the applicant, whether the final decision is in his favor or not."

This Court in the case of Butterworth *v.* Hoe, 112 U. S. 50, 61, distinguished between a proceeding by appeal under section 4911 and that by bill in equity under 4915. It is there stated that when an application for a patent has

been refused either by the Commissioner of Patents or by the Supreme Court of the District of Columbia (now Court of Appeals), after appeal to it under section 4911 applicant may have remedy by bill in equity under section 4915 Revised Statutes. And in referring to the proceeding by bill in equity and in distinguishing it from an appeal under section 4911 this language is used:

"This means a proceeding in a court of the United States having original equity jurisdiction under the patent laws, according to the ordinary course of equity practice and procedure. It is not a technical appeal from the Patent Office, like that authorized in section 4911, confined to the case as made in the record of that office, but is prepared and heard upon all competent evidence adduced and upon the whole merits."

It is thus seen that in the matter of taking an appeal the right is conferred by a proceeding wholly separate and different from and in the alternative to section 4915, Revised Statutes. In short, these two sections 4911 and 4915 provide for separate proceedings, each of which is governed by its own limitations and regulations. To discuss the two together as in anywise related in the matter of a time limit under section 4911 is simply to invite confusion. Under section 4911 as amended by the act establishing the Court of Appeals of the District of Columbia, an *appeal* is provided to the Court of Appeals of the District of Columbia—an Appellate Court, not a Court of original jurisdiction—as provided by section 4915, Revised Statutes.

The Appellate Court on petition is to hear and determine the appeal and to revise the decision of the Commissioner of Patents appealed from in a summary way "on the evidence produced before the Commissioner, at such early and convenient time as the Court may appoint." Section 4914.

It is to be observed from the wording of this section, aside from the dissimilarity between the proceeding under it and that under section 4915, that the words of section 4914 have to do solely with an appellate proceeding, which

proceeding, in the nature of the Court, would be governed by the rules and regulations of the Court. Here, then, it may be seen that an applicant whose claims have been rejected by the Commissioner of Patents may abandon his right of appeal by reason of some regulation or rule of the appellate court, and yet not abandon his right to file a bill in equity in a court of original jurisdiction by reason of section 4894. This would seem to indicate that there may be abandonment or forfeiture of the right to appeal without an abandonment of the application. But this discussion is simply had in order to disclose to the understanding of the Court that sections 4894 and 4915 and the decision in Gandy *v.* Marble are not involved, in view of acts relating to the Court of Appeals, in determining the question whether that Court has authority to fix a time limit of appeal from a decision of the Commissioner of Patents. Whatever argument might be adduced from these sections of the statute as to a limit of time in which appeal might be taken to the Court were the law establishing the Court of Appeals and the Rules of the Court not such as they are, such argument, in view of said laws and rules, is purely on what might be, and not what is. This, in short, seems to be the petitioner's whole contention.

## ANSWER TO THE SEVENTH POINT.

Answering the seventh point, the facts in the matter are simply these: The petitioner had a right of appeal to the Court of Appeals from the decision of the Commissioner of Patents refusing claims 1 and 2, but which right he lost by reason of his failure to take an appeal within the time provided by the rules of the Court of Appeals. The only other right that the petitioner had as to these claims, was the right to file a bill in equity under section 4915, Revised Statutes. Thus the petitioner had two years within which to take a certain kind of action, to wit: a bill in equity, but he had not *two years*, but only a period of *forty days* to take a certain other kind of action on his case; that is, an appeal to the Court of Appeals of the District of Columbia.

## ANSWER TO THE EIGHTH POINT.

As to what the petitioner states under the eighth point, that has been reviewed and answered under the answer to the sixth and seventh points.

## ANSWER TO THE NINTH POINT.

As to the ninth point it may be stated that the matter referred to thereunder was not made by the respondent except to show that it might be argued better that section 4904 governed the time for taking an appeal in an interference case—the petitioner's case being such—to the Court of Appeals than to argue that section 4894, Revised Statutes, fixed the time for taking an appeal. In other words, to show the incorrectness of the petitioner's argument that section 4894, Revised Statutes, governed the time within which appeals might be taken to the Court of Appeals, the respondent argued with better logic or truth that section 4904 might be assumed as regulating the time of appeals in interference or contested cases. It is, however, disclaimed that either of these sections of the statute governs the time of taking an appeal to the Court of Appeals either in an *ex parte* case or contested case, as this is a matter governed by the law of the Court and the rules of the Court established thereunder.

As to the contention of the petitioner that there are no contested cases in the Patent Office, it is submitted that an interference case is in its very nature a contested case, and it is specifically so stated by the statute.

"SEC. 4905. The Commissioner of Patents may establish rules for taking affidavits and depositions required in cases pending in the Patent Office, and such affidavits and depositions may be taken before any officer authorized by law to take depositions to be used in the courts of the United States or of the State where the officer resides.

"SEC. 4906. The clerk of any court of the United States, for any district or Territory wherein testimony is to be taken for *use in any contested case pending in the Patent Office*, shall, upon the application of any party thereto, or of his

agent or attorney, issue a subpœna for any witness residing or being within such district or Territory, commanding him to appear and testify before any officer in such district or Territory authorized to take depositions and affidavits, at any time and place in the subpœna stated. But no witness shall be required to attend at any place more than forty miles from the place where the subpœna is to be served upon him."

To the statement that the Patent Office is "not in any sense a court," it seems to be only necessary to refer to this Court's decision in the case of Butterworth *v.* Hoe, 112 U. S. 50, 64.

To petitioner's argument that respondent is trying to make a distinction between *ex parte* and contested cases it may be said that the respondent makes no such contention. On the contrary, the respondent agrees to the proposition that so far as the time of appeal to the Court is concerned any law or rule is equally applicable to both. If the respondent had been disposed to make an argument of this kind he might have shown that in practice there is a great difference in allowing an *ex parte* applicant two years in which to appeal and in allowing a defeated contesting party two years in which to appeal. In an *ex parte* case the applicant is refused a patent, and he rests under the refusal at his own risk and loss without affecting any other party or the public at large. Not so however with a defeated contesting party, even were the Commissioner of Patents to issue the patent to the successful party. Its validity would be open to question as to priority of invention by an appellate proceeding until after the expiration of two years within which the defeated party might appeal. This cloud would materially affect the value of the patent.

Moreover, the defeated party could wait for a period of two years to take his appeal, and if he suffered defeat in the Appellate Court he could file a bill in equity within another two years and thereby harrass the patentee for a period of fully four years without accomplishing anything more, so far as expediting a final judgment between him